## REMARKS

Applicants have amended Claims 1, 3, 4, 10, 11, 15-17, and 23. Support for these amendments are found from line 4 of page 7 through line 31 of page 8, lines 5-7 of page 10, and page 13, lines 4-7 of the instant specification as filed. Applicants have cancelled Claims 2, 5, 7-9, 13, and 24. Therefore the Claims currently under consideration are Claims 1, 3, 4, 10, 11, 15-17, 19, and 23.

### *Claim Objections*

The Examiner has objected to Claims 2-5, 7-11, 13 and 15-17 as the Examiner states that in line 1, "A foam control composition" should be changed to –A granulated foam control composition— and that appropriate correction is required.

Applicants have amended Claims 3, 4, 10, 11, and 15-17 in accordance with the suggestion of the Examiner. Therefore Applicants request the Examiner to withdraw the objection.

### *Double Patenting*

The Examiner has rejected Claims 1-3, 7-11, 13, 15-17, 19, and 23-24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-6, 11-12, 14, 16-18, 20 and 24-25 of copending Application No. 10/521,416. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason: Claims 1-6, 11-12, 14, 16-18, 20 and 24-25 of the copending Application is directed to a foam control composition comprising a polydiorganosiloxane, a hydrophobic filler having a specific particle size, a non-polar polyol ester, which obviously read on the instant claim of the present invention. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants, through the present amendment, have distinguished the instant invention from copending Application No. 10/521,416. Independent Claims 1 and 23 as currently amended are drawn to a granulated foam control composition comprising (i) a foam control agent and (ii) an

an additive composition of melting point 35 to 100°C comprising: a polyol ester selected from glycerol triesters, esters of pentaerythritol, or a mixture of glycerol triesters and optionally 5 to just less than 50% by weight of a component (B) selected from fatty alcohols, fatty acids, or mixtures of monoesters and diesters of glycerol.

In contrast, independent Claims 1 and 24 of copending Application No. 10/521,416 are drawn to a granulated foam control composition comprising (i) a foam control agent and (ii) an additive composition of melting point 35 to 100°C comprising: 5-50 parts by weight of a glycerol triester (A) and 50-95 parts by weight of a mixture of monoesters and diesters of glycerol (B). Thus it is clear to one skilled in the art that component (B) of the instant invention is optional, and even if it is present, it is present in an amount that is clearly less than the amount of Component (B) of copending Application No. 10/521,416.

Therefore Applicants believe they have overcome the rejection and respectfully request the Examiner to withdraw the double patenting rejection.

***Claim Rejections - 35 USC § 102***

Claims 1, 3 10-11, 13, 15-17, 19, 23, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Dickinson (GB 1 523 957). The Examiner argues that Dickinson discloses a method for manufacturing a granular foam control composition comprising a polydiorganosiloxane containing radicals such as ethyl, propyl, octyl, tetradecyl, phenyl, benzyl, 2-phenylpropyl, etc., waxes such as polyethylene wax (a paraffin wax), microcrystalline wax, etc. having specific melting points, a silica or aluminum oxide and an emulsifying agent such as polyoxyethylene distearate. (page 1, line 21 to page 2, line 28 and Examples). Since the silica is compounded in the presence of the ingredients such as the polysiloxanes and/or the MQ resin, it is inherently surface-modified in-situ. The amount of the wax and emulsifying agent (i.e., additive composition) is described in page 2, lines 52-65. The granulated foam control agent is prepared by utilizing the foam control composition supported on a particulate carrier such as sodium tripolyphosphate, etc. in non-aqueous liquid form, (page 2, lines 29-43 and Examples).

Applicants, through the present amendment, have amended independent Claims 1 and 23, and the claims depending therefrom, to recite that the an additive composition of melting point 35 to 100°C comprises: (A) a polyol ester selected from glycerol triesters, esters of pentaerythritol, or a mixture of glycerol triesters and optionally 5 to just less than 50% by weight of a component (B) selected from fatty alcohols, fatty acids, or mixtures of monoesters and diesters of glycerol.

Dickinson fails to disclose or suggest the foam control composition as now recited in Claims 1 and 23 and claims depending therefrom Nowhere in Dickinson is the additive composition of component (ii) comprising: (A) a polyol ester selected from glycerol triesters, esters of pentaerythritol, or a mixture of glycerol triesters and optionally 5 to just less than 50% by weight of a component (B) selected from fatty alcohols, fatty acids, or mixtures of monoesters and diesters of glycerol disclosed or taught. There is no evidence or suggestion in Dickinson of a granulated foam control composition comprising an additive composition comprising a polyol ester selected from glycerol triesters, esters of pentaerythritol, or a mixture of glycerol triesters and optionally a second component selected from fatty alcohols, fatty acids, or mixtures of monoesters and diesters of glycerol. Therefore Applicants do not believe that Dickinson anticipates the Claims as currently amended.

Therefore, the applicants request that the rejection under 35 U.S.C. §102(b) be withdrawn and the claims allowed to issue.

***Claim Rejections – 35 USC § 103***

Claims 1-5, 7-11, 13, 15-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US 6 610 752) in view of L'Hostis (EP 1 075 863).

The Examiner states that for Claims 1-5, 7-11, 15, 15, 17, and 19 Schmid discloses a method of manufacturing a granular foam control composition comprising a polydiorganosiloxane containing methyl, ethyl, propyl, butyl and phenyl groups, a microfine silanized silica, a polyol ester such as the esters of glycerol and palmitic acid (typically containing a mixture of glycerol mono-, di-, and tripalmitate), a bisamide, a fatty acid, a microcrystalline paraffin wax. (col. 2, line 34 to col. 5, line 56 and Examples). The Examiner states that silica can be silanized and dispersed

states that silica can be silanized and dispersed into the polydiorganosiloxane (col. 2, line 34 to col. 3, line 18). The Examiner states that granular foam control composition can be prepared according the method described in col. 3, line 19 to col. 4, line 13, col. 5, line 57 to col. 7, line 67 and Examples. The Examiner admits that Schmid is silent on the polydiorganosiloxane where the substituents have the claimed mean number of carbon atoms, the claimed long chain alkyl group or the claimed X-Ph moiety.

The Examiner states that L'Hostis teaches the use of in a foam control composition a polyorganosiloxane and a silicone resin that read on the claimed ones. The Examiner argues that the motivation of using the specific polyorganosiloxane and the silicone resin is to afford a granular foam control composition with enhanced foam control efficiency (col. 2, lines 46-51, col. 2, line 64 to col. 3, line 46, col. 4, line 64 to col. 5, line 28 and col. 7, line 65 to col. 8, line 35). The Examiner states that in light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize L'Hostis' polyorganosiloxane and silicone resin in Schmid's composition with expected success, especially since L'Hostis is in the same field as that of Schmid's endeavor. The Examiner also states that Schmid teaches depositing the polydiorganosiloxane, polyol ester, etc. in aqueous liquid form on the particular carrier (col. 2, lines 5-30). However, the water is eventually removed (col. 22, lines 12-25). The Examiner then argues that therefore the prior art's granulated foam control composition is obviously the same as the claimed granulated foam control composition where the polydiorganosiloxane, polyol ester, etc., is used in non-aqueous form.

The Examiner states that for Claim 16, Schmid is silent on the microfine silanized silica having the claimed average particle size. The Examiner state that L'Hostis teaches that it is well known to use hydrophobic fillers such as silica with particle size of 0.5 to 50 microns for foam control agents. The silica is well known and is commercially available, (col. 6, line 60 to col. 7, line 28) The Examiner argues that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize L'Hostis' silica filler in Schmid's composition because Schmid's silica is microfine and because of the commercial availability of L'Hostis' silica, especially since L'Hostis is in the same field as that of Schmid's endeavor, and Applicants do not show the criticality of the particle size.

Schmid et al. fails to disclose or suggest the foam control composition as now recited in Claims 1 and 23 and claims depending therefrom. Nowhere in Schmid et al. is the additive composition of component (ii) comprising (A) a polyol ester selected from glycerol triesters, esters of pentaerythritol, or a mixture of glycerol triesters and optionally 5 to just less than 50% by weight of a component (B) selected from fatty alcohols, fatty acids, or mixtures of monoesters and diesters of glycerol as currently recited Claims 1 and 23 and claims depending therefrom disclosed or taught. There is no evidence or suggestion in Schmid et al. of a foam control composition comprising (i) a foam control agent and (ii) an additive composition comprising (A) a polyol ester selected from glycerol triesters, esters of pentaerythritol, or a mixture of glycerol triesters and optionally 5 to just less than 50% by weight of a component (B) selected from fatty alcohols, fatty acids, or mixtures of monoesters and diesters of glycerol as currently recited Claims 1 and 23 and claims depending therefrom. Furthermore there is no evidence or suggestion in Schmid et al. of the use of a silicone resin in their defoamer granules.

In L'Hostis nowhere is an additive composition disclosed or taught in their silicone foam control granule. There is no evidence or suggestion in L'Hostis of a composition containing the foam control agent of Claims 1 or 23 and an additive composition comprising a polyol ester selected from glycerol triesters, esters of pentaerythritol, or a mixture of glycerol triesters and optionally 5 to just less than 50% by weight of a component selected from fatty alcohols, fatty acids, or mixtures of monoesters and diesters of glycerol as currently recited Claims 1 and 23 and claims depending therefrom. Therefore Applicants find no suggestion to combine the teachings and suggestions of Schmid et al. and L'Hostis as suggested by the Examiner except from using Applicants' invention as a template through a hindsight reconstruction of Applicants claims. Applicants further conclude that an artisan having common sense at the time of the invention would not have reasonably considered adding a siloxane resin to a foam control composition comprising an additive composition containing a polyol ester selected from glycerol triesters, esters of pentaerythritol, or a mixture of glycerol triesters and optionally 5 to just less than 50% by weight of a component selected from fatty alcohols, fatty acids, or mixtures of monoesters and diesters of glycerol as currently claimed. Furthermore, even if the disclosures of Schmid et al. and L'Hostis are combined, Applicants invention as recited in the Claims above is not arrived at.

Therefore, the applicants request that the rejection under 35 U.S.C. §103 be withdrawn and the claims allowed to issue.

The Examiner has also rejected Claims 2 and 24 under 35 U.S.C. 103(a) as being unpatentable over Dickinson in view of Schmid.

The Examiner states that Dickinson discloses a method of manufacturing a granular foam control composition, supra, which is incorporated by reference. The Examiner states that the composition can contain a water-insoluble wax such as polyethylene wax (a paraffin wax), etc. (page 2, lines 18-20). The Examiner admits that Dickinson is silent on the specific use of a glycerol triester. The Examiner however argues that Schmid teaches a method of manufacturing a granular foam control composition utilizing an water-insoluble wax, such as paraffin wax, glycerol triester, etc. (col. 4, line 14 to col. 5, line 56), and therefore Schmid does teach equivalency between paraffin wax and glycerol triester for preparing granular foam control compositions. Therefore the Examiner argues that it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the glycerol triester in Dickinson's composition with expected success, especially since Schmid is in the same field of endeavor as Dickinson.

This rejection has been rendered moot by the cancellation of Claims 2 and 24. However Applicants will address the rejection in light of Claims 1 and 23 as currently amended. Applicants believe that Dickinson has been distinguished from the instantly claimed invention as discussed above, and the arguments related thereto are incorporated into this discussion by reference. Applicants believe that Schmid has also been distinguished from the instantly claimed invention as discussed above, and the arguments related thereto are incorporated into this discussion by reference. Nowhere in Dickinson is there any suggestion to combine the teachings and suggestions of Schmid as suggested by the Examiner except from using Applicants' invention as a template through a hindsight reconstruction of Applicants claims. Applicants further conclude that an artisan having common sense at the time of the invention would not have reasonably considered adding the glycerol triester disclosed in Schmid to the foam control composition of Dickinson. Again the Examiner is using Applicants' specification as a template for a hindsight reconstruction of Applicants claims. Nowhere in Dickinson is there any evidence that Dickinson

that Dickinson considered using glycerol triesters as additives to their foam control compositions. Furthermore, there is no motivation supplied to one skilled in the art (such as Dickinson) to utilize the glycerol triesters of Schmid, who apply their compositions in aqueous emulsion form to their support material, in a composition where the foam control agent and additive composition are deposited on a particulate carrier in non-aqueous liquid form. Thus Applicants do not believe that Claims 1 and 23 are unpatentable over Dickinson in view of Schmid.

Therefore, the applicants request that the rejection under 35 U.S.C. §103 be withdrawn and the claims allowed to issue.

Applicants hereby petition for any necessary extensions of time. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application. You are authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to deposit account 04-1520.

Respectfully Submitted,
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